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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,610	08/24/2001	Huiping Li	37112-173148	8980

Venable
P.O. Box 34385
Washington, DC 20043-9998

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06/16/2008

EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2628

MAIL DATE	DELIVERY MODE
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06/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/935,610	Applicant(s) LI ET AL.	
	Examiner Jeffery A. Brier	Art Unit 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 29-38 is/are rejected.
- 7) ☒ Claim(s) 27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendments filed on 03/19/2008 and 12/13/2007 have been entered and overcome the 35 USC 112 second paragraph rejection and 35 USC 101 non-statutory rejection based on preemption.

Response to Arguments

2. Applicant's lack of arguments in the response filed 03/19/2008 and 12/13/2007 concerning the 35 USC 101 non-statutory rejection of claim 26 based on signals is noted. See the Final Rejection mailed on 08/14/2007 at pages 8 and 9. This rejection is maintained and repeated in a modified form below. The change in claim form raises the issue of whom or what performs the claimed method present in claims 1-25 and 29-38. A rejection based upon this issue is set forth below.

Specification

3. The disclosure is objected to because of the following informalities: Paragraph [0014] defines computer-readable medium as "any storage device used for storing data accessible by a computer" and then lists a number of storage devices and then alleges that a "carrier wave used to carry computer-readable electronic data" is a storage device. This definition appears to incorrectly associate a "device" to a "carrier wave". Note any changes to this definition affects claims 26-28. The specification should continue to limit the computer-readable medium to the computer storage devices listed

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in paragraph [0014] except for "carrier wave" which is not a "device" and not a "storage device". Thus, the computer-readable medium is "any storage device used for storing data accessible by a computer. Examples of a computer-readable medium include: a magnetic hard disk; a floppy disk; an optical disk, like a CD-ROM or a DVD; a magnetic tape; a memory chip" and the computer-readable medium is not "a carrier wave used to carry computer-readable electronic data, such as those used in transmitting and receiving e-mail or in accessing a network". Note the below 35 USC 101 rejection concerning signals.

Appropriate correction is required.

Claim Objections

4. Claims 35-38 are objected to because of the following informalities: claim 35 at line 6 "step" should be "steps" and dependent claims 36-38 do not correct this minor informality present in parent claim 35. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-26 and 29-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-25 and 29-38:

The method claims cover a human mentally performing the method which was found to be non-statutory in *In Re Comiskey* since the claimed method "to be performed by video processing equipment" covers a human mentally performing the method since the claim does not exclude the method being performed by a human mentally and since claims 27 and 28 are evidence claims that claims 1-25 and 29-38 are claiming a method rather than video processing equipment performing a process. *In re Comiskey*, 84 USPQ2d 1670 (Fed. Cir. 2007). Note pages 1677 to 1679.

Page 1679 states:

It is thus clear that the present statute does not allow patents to be issued on particular business systems—such as a particular type of arbitration—that depend entirely on the use of mental processes. In other words, the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable.

Claim 26:

In view of applicants specification at paragraph [0014] the claimed computer-readable medium is any tangible medium which stores the computer-executable code, including signals. Signals were found to be non-statutory in *In re Nuijten*. *In re Nuijten*, 84 USPQ2d 1495 (Fed. Cir. 2007) and *In re Nuijten*, 85 USPQ2d 1927 (Fed. Cir. 2008). Note the above objection to the specification.

Allowable Subject Matter

7. Claims 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the objection to the specification is correctly corrected.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael

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Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/
Primary Examiner, Division 2628